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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NEWHOUSE, NATHAN JEFFREY

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,594

Applicant(s)

WILLIAMS ET AL.

Examiner

Nathan J. Newhouse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I. in Paper No. 2 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, claims 21-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 2.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 28, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application.

The original disclosure does not support the showing of collapsible rails 26 being formed in a series of segmented portions. Moreover, portions of the rails 26 appear to disappear when the rails are in the collapsed position (portion above mounting elements 50 and forward of the mounting element 50—shown in figure 1, but not in figure 2). It is further unclear how the portion forward to the mounting element 50 of figure 1 can be collapsed as it would appear that this portion of the rail is permanently attached to the roof of the vehicle. The labeling of hinge bars is new matter. These parts, as originally filed, may or may not have been hinge bars.

The proposed drawings are further disapproved as there are numerous reference numbers that are not referenced in the substitute specification filed concurrently with these drawings. For example, 53, 55, 47, etc.

Appropriate correction is required in response to this office action.

Specification

3. The substitute specification filed on July 28, 2003 does not accurately reflect applicant's previous amendments. If it is applicant's intent to remove the subject of the previous amendments, then applicant should have submitted a marked-up copy showing these changes as well as a clean copy of the specification. Since it is unclear what applicant's intent was, the substitute specification has not been entered. Therefore the previously filed amendment to the specification is still part of the specification.

The amendment filed November 12, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

A) paragraph 17—multiple segments that form each of the original collapsible side rails 26. As evidence that this was not part of the original disclosure, applicant has amended the drawings, specifically figure 1 to shown that side rails 26 are formed of segments and labeled these segments. Moreover, portions of the rails 26 appear to disappear when the rails are in the collapsed position (portion above mounting elements

50 and forward of the mounting element 50—shown in figure 1, but not in figure 2). It is further unclear how the portion forward to the mounting element 50 of figure 1 can be collapsed as it would appear that this portion of the rail is permanently attached to the roof of the vehicle. In addition, it is unclear how these segments are held to adjacent segments to form the upright position shown in figure 1.

B)paragraph 17—collapsible rails being attached by hinge bars. The original specification does not contain any reference to these hinge bars. While applicant's original drawings show the collapsible rail in the upright position (figure 1) and the collapsed position (figure 2), there is no indication that this is a result of the rails being attached by hinge bars. By way of example, the collapsible rails could be fitted into different holes in the roof rack, one set of holes for the upright position of figure 1 and a second set of holes for the collapsed position of figure 2. Moreover, it is unclear how the rails collapse and where different portions of the rail 26 disappear to in the collapsed position (portion above mounting element 50 (between portion 14 and storage surface 20) and the forward portion of rail 26 that appears to be permanently connected to the roof as shown in figure 1.

C)paragraph 18—track elements hingedly affixed to the connecting members. There is no mention in the original specification about a hinge connection between the track elements and the connection members. The track elements 36 were described originally to slide along the connection members 38. It is unknown how the storage surface 20 hinges downwardly to the position of figure 2. It may be by this connection or it may be a separate hinge on each track element, etc. In addition, it should be

noted that there is no connection member for the track element 36 to slide on in figure 2(closest to #40).

D)paragraph 19—multiple segments forming the collapsible side rails 26. See part A) above.

E)paragraph 20—latching areas being defined by recesses. The originally filed specification does not mention recesses. Likewise, the drawings do not show recesses.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 35-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims recite various newly described features that were not part of applicant's originally filed specification. Applicant's extremely vague, brief written description does not render the ordinary artisan to make and use the subject matter in the invention set forth in the claims. Applicant's attempts to satisfy the written requirement via the amendments to the disclosure clearly raises new matter and

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provides no merit as to the proper description, operation and use to the invention within the level of skill of an ordinary artisan.

By way of example, claim 35 recites a hinge connection between 1st and 2nd guide rails and 1st and 2nd connecting members. Previous description suggests that this connection is only for sliding. Claim 37 sets forth a recess that was not previously set forth. Claim 38 sets forth a hinge bar to attach the collapsible rails. Claims 38 and 39 set forth collapsible rails that are hingedly connected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 35-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Aftanas et al. 6,338,427.

Aftanas et al. teaches a roof rack with a collapsible storage surface 202 as the storage surface moves from atop the roof of the vehicle to behind the vehicle. The storage surface is movable between a first position or closed position atop of the vehicle (figure 18) and a second position or deployed position behind the vehicle (figure

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19). First and second rails 218 allow first and second connecting members 210 to slide along to move the storage surface between figure 18 and 19. The first and second connecting members 210 are also hinged as shown. There is at least one mounting element 214 on the side and recesses 212 to provide a place for attachment.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aftanas et al. 6,338,427 in view of Parkins(GB1043227).

Aftanas et al. teaches rails 204 and 206 that form storage surface 202, but Aftanas et al. does not teach rails 204 as being collapsible or hingedly connected.

Parkins teaches a similar roof rack having rails 24 that are hingedly connected to the front and rear rails of the roof rack to allow for the rails 24 to collapse and extend upwardly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide rails 24 as taught by Parkins in place of rails 204 on Aftanas et al. to increase the storage capacity of the roof rack.

Response to Arguments

10. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive.

With respect to applicant's arguments concerning the new matter rejection of the specification and the drawings, applicant makes reference to the provisional application 60/259,005 and states that the added subject matter is contained in this provisional application. Upon examination of this provisional application, the subject matter of applicant's originally filed specification and the provisional application are the same.

The drawings filed in the provisional application, specifically figures 8A, 8B, and 9-13 are similar to the originally filed drawings of the instant application. Therefore, the added subject matter contained in the amendment filed November 12, 2002 to the specification and the drawings of November 12, 2002 does not have support in the provisional application. Specifically, certain features added in the amendment and drawings of November 12, 2002 have no support in the originally filed drawings, specification or in the provisional application. For example, the collapsible rails are not adequately described as to how or what portions are collapsible; where portions of these collapsible rails disappear to when in the storage position (portion above the mounting elements 50 in figure 1); and how certain portions of the collapsible rails are capable of being collapsed (portion forward of right most mounting element 50 in figure 1) as this portion appears to be permanently affixed to the vehicle. The specifics added in describing how the collapsible storage surface slides was not previously set forth. The originally filed specification, drawings and provisional application did not describe the rails or track elements that allows for the storage surface to move from atop the vehicle to the side. The hinge bars which allow the collapsible rails to fold into the storage position were not previously set forth. It is not readily apparent that the

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collapsible rails were hinged from the drawings in the provisional application and as there was no description of this in the specification of the provisional application, there is no support to now add that subject matter.

With respect to applicant's arguments concerning the rejection under 35 USC 102, these arguments are not persuasive. As set forth in the above rejection, the newly added subject matter to the claims does not define over Aftanas et al. The storage surface of Aftanas et al. is "collapsible" as it moves from atop the vehicle to behind the vehicle.

With respect to applicant's arguments concerning the rejection under 35 USC 103, these are not found persuasive as the combination clearly teaches a collapsible storage surface as the rails of Aftanas et al. are modified as taught by Parkins to be hinged to allow the storage surface to hold more stuff when the rails are in there upright position.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan J. Newhouse whose telephone number is (703)-308-4158. The examiner can normally be reached on Monday-Thursday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on (703)-308-2572. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.


Nathan J. Newhouse
Primary Examiner
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